

REMARKS

Claims 1-24 are currently pending in the present application. Claims 1, 12, 18, and 20 have been amended.

IDS

The Examiner has refused to consider the Information Disclosure Statement filed on April 7, 2006. The Examiner stated that "[t]he document presents factual evidence relating to the patentability of the invention without proper affidavit support." Applicant is unaware of any requirement that information provided to the Examiner under 37 C.F.R. § 1.56 needs to be in the form of the affidavit. As such, applicant respectfully requests that the Examiner point to the rule that requires a document that presents factual evidence related to patentability to be in the form of an affidavit.

Written Description

The Examiner has rejected claims 1-24 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Applicant respectfully traverses this rejection. According to controlling case law, "the disclosure 'must ... convey with reasonable clarity to those skilled in the art that ... [the inventor] was in possession of the invention.'" *Purdue Pharma L.P. v. Faulding Inc.*, 230 F.3d 1320, 1323, 56 USPQ2d 1481, 1483 (Fed. Cir. 2000) (quoting *Vas-Cath Inc. v. Mahurkar*, 935 F.2d 1555, 1563-64, 19 USPQ2d 1111, 1117 (Fed. Cir. 1991)). "Put another way, one skilled in the art, reading the original disclosure, must 'immediately discern the limitation at issue' in the claims." *Id.* (quoting *Waldemar Link GmbH & Co. v. Osteonics Corp.*, 32 F.3d 556, 558, 31 USPQ2d 1855, 1857 (Fed. Cir. 1994)). Moreover, "[t]here is a strong presumption that an adequate written description of the claimed invention is present when the application is filed." (MPEP 2163(A).)

Applicant respectfully submits that one skilled in the art, reading the original disclosure, would immediately discern the limitations at issue in the claims. The Examiner only explicitly mentions the language of claim 7 in discussing this rejection. Claim 7 recites

a flip command for flipping the selected objects and the multiple selection highlight object along a repositionable axis pin. One skilled in the art would understand that an object can be flipped horizontally or vertically. See, e.g., Micrografx at 9-26 (teaching "[y]ou can flip a symbol horizontally"). One skilled in the art would, upon reading the original disclosure, specifically Figures 5A and 5B and paragraphs [0076-0080], would immediately discern the flip command of claim 7. Figure 5A shows selected objects bounded by the multiple selection highlight object whose axis pin 516 has been repositioned from its typical location at the center or approximate center of the multiple selection highlight object. Figure 5B shows the result of the flip command along a horizontal reference axis. Other claim limitations, such as selecting objects, displaying a multiple selection highlight object, and configuring the selected objects to be manipulated, are also immediately discernable to one skilled in the art reading the original disclosure.

Moreover, all of these limitations were in the original claims. As such, there is a strong presumption that the written description requirement is satisfied. In addition, the Examiner concedes that the specification indicates that applicant had the "idea of the invention." (Office Action, Nov. 11, 2006, p. 3.) Clearly, if applicant had the "idea of the invention," applicant was in possession of the invention, which is sufficient to satisfy the written description requirement. In addition, because one skilled in the art, reading the original disclosure, would immediately discern the limitations at issue in the claims, the disclosure conveys with reasonable clarity to those skilled in the art that applicant had possession of the invention when the application was filed. As a result, the Section 112, first paragraph rejection of claims 1-24 as failing to comply with the written description requirement should be withdrawn.

Enablement

The Examiner has rejected claims 1-24 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. Applicant respectfully traverses this rejection. According to controlling case law, "[t]he enablement requirement is satisfied when one skilled in the art, after reading the specification, could practice the claimed

invention without undue experimentation." *AK Steel Corp. v. Sollac*, 344 F.3d 1234, 1244, 68 USPQ2d 1280, 1287 (Fed. Cir. 2003) (citing *In re Wands*, 858 F.2d 731, 736-37, 8 USPQ2d 1400, 1404 (Fed. Cir. 1988)). "As a general rule, where software constitutes part of a best mode of carrying out an invention, description of such best mode is satisfied by a disclosure of the functions of the software. This is because, normally, writing code for such software is within the skill of the art, not requiring undue experimentation, once its functions have been disclosed." *Fonar Corp. v. General Electric Co.*, 107 F.3d 1543, 1549, 41 USPQ2d 1801, 1805 (Fed. Cir. 1997).

Applicant respectfully submits that one skilled in the art, after reading the specification, could practice the claimed invention without any experimentation, let alone undue experimentation. As support, applicant previously submitted a 37 C.F.R. § 1.132 declaration stating that one skilled in the art, after reviewing the specification and drawings, could have added the features of the currently claimed invention to a graphics software application with less than one month of effort. This period includes normal implementation and testing of the features. Applicant respectfully submits that this one month period does not constitute undue experimentation.

Furthermore, the Examiner states that because "[t]he disclosure merely describes what is done with the objects, not how to do the highlighting, manipulation, selection, and de-selection of the objects", the specification does not meet the enablement requirement. Applicant respectfully disagrees. According to the Manual of Patent Examining Procedure and controlling case law, "[t]he specification need not disclose what is well known in the art." *In re Buchner*, 929 F.2d 660, 661, 18 USPQ2d 1331, 1332 (Fed. Cir. 1991) (citing *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1463, 221 USPQ 481, 489 (Fed. Cir. 1984)); see also MPEP 2164.01. The highlighting, manipulation, selection and de-selection of objects features are well-known in the art. For example, Omura at 42 teaches selection and highlighting of objects and Cohen at 88-92 teaches manipulation of objects with handles. As these features are well-known in the art, the specification need not disclose them.

Because one skilled in the art, after reading the specification, could practice the claimed invention without any experimentation, applicant's disclosure meets the enablement requirement. As a result, the Section 112, first paragraph rejection of claims 1-24 as failing to comply with the enablement requirement should be withdrawn.

35 U.S.C. § 103(a)

The Examiner has rejected claims 1-6, 9-14 and 16-24 under 35 U.S.C. § 103(a) as being unpatentable over Omura in view of Cohen, and claims 7, 8, and 15 under 35 U.S.C. § 103(a) as being unpatentable over Omura in view of Cohen and further in view of Micrografx. Even though applicant respectfully disagrees with the basis of these rejections, applicant has amended claims 1, 12, 18, and 20 to more accurately convey the subject matter for which applicant seeks protection.

Applicant's techniques provide "the capability to select and manipulate multiple objects with respect to a common reference and/or by a single operation without the need to permanently transform or group the objects to form a new object or to later transform or ungroup the objects in order to manipulate one or more of them individually." (Specification, [0009]).

The pending rejected claims each recite a multiple selection highlight object that bounds the selected objects without permanently grouping them. For example, claim 1 recites "a multiple selection highlight object that bounds the selected objects for purposes of manipulating the selected objects without permanently grouping the selected objects." Omura does not disclose or suggest a multiple selection highlight object that bounds the selected objects without permanently grouping them. Rather, Omura apparently discloses that when multiple objects are selected, subsequent manipulation operations can be performed only on the grouped multiple objects, and not on individual objects, *until the grouped multiple objects are ungrouped*. For example, Omura at 42-44 describes selecting a door (composed of four individual line objects), and moving the entire door, without disclosing or suggesting the ability to manipulate the line objects individually, *until*

the grouped line objects are ungrouped by unselecting line objects individually. Because Omura does not disclose or suggest a multiple selection highlight object that bounds the selected objects without permanently grouping them, each of the pending claims is patentable over Omura.

Based upon these amendments and remarks, applicant respectfully requests reconsideration of this application and its early allowance. If the Examiner has any questions or believes a telephone conference would expedite prosecution of this application, the Examiner is encouraged to call the undersigned representative at (206) 359-8598.

Dated: 2-14-07

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